

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	DAVID W DOERNER et al.	Examiner:	Annan Q. Shang
Serial No.:	09/474,783	Group Art Unit:	2623
Filed:	December 30, 1999	Docket No.:	1020P6929
Title:	SYSTEM FOR CONTROLLING USE OF BROADCAST CONTENT		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants have carefully reviewed and considered the Final Office Action mailed on July 18, 2007 and the cited references. In response to the Final Office Action, Applicants respectfully request review prior to the filing of an Appeal Brief.

Claim Rejections – 35 USC §103(a)

Claims 1, 4-7 and 12-25 were rejected under 35 USC 103(a) as being unpatentable over Gotwald (U.S.5,987,518) in view of Horton et al (U.S. 4,945,563) and further in view of Russo (U.S. 5,619,247).

Applicants respectfully traverse these rejections.

REMARKS

Applicant respectfully submits that Gotwald, Horton et al., and Russo, whether taken alone or in combination, are insufficient to establish a *prima facie* case of obviousness with respect to the amended independent claims. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second,

there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1, 4-7 and 12-25. Therefore claims 1, 4-7 and 12-25 define over Gotwald, Horton and Russo whether taken alone or in combination. For example, claim 1 recites "a pay-per-use Internet Protocol (IP) television broadcast stream." Applicant respectfully submits that neither Gotwald, Horton and Russo teaches or suggests a pay-per-use Internet Protocol (IP) television broadcast stream as recited in claim 1. For example, the cited portion of Gotwald arguably discloses the encapsulation of IP data within a standard MPEG2 video stream. The cited portions of Gotwald make it clear that the disclosed video stream is a standard MPEG2 video stream and is not an IP stream. Therefore, Gotwald, Horton and Russo, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

Additionally, Gotwald, Horton and Russo fail to teach, suggest or disclose indicating "a number of times the playback device may reproduce the received broadcast content" as recited in independent claim 1. According to the Office Action, this limitation is disclosed by Russo at Col. 5, lines 1-47. Applicant respectfully disagrees. Russo at the given cite, in relevant part, states, "a viewer may be allowed to view a selected program as many times as desired over a particular, predetermined period of time." Applicant respectfully submits that allowing a selected program to be viewed as many times as desired for a predetermined period of time, as taught by Russo, is different than restricting "a number of times the playback device may reproduce the received broadcast content." Applicant submits that Russo in fact actually teaches

away from limiting the number of times broadcast content may be reproduced. Therefore, Gotwald, Horton and Russo, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

Once again, Applicant respectfully submits that the cited references, taken alone or in combination, also fail to teach suggest or disclose “a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content” as recited in independent claim 1. According to the Office Action, the missing language is disclosed by Horton at column 3, lines 38-67. Applicant respectfully disagrees. Horton at the given cite, in relevant part, states:

The receiver 20 includes a descrambling circuit 26 which descrambles the television program and feeds it to a decoder 28. The decoder 28 decodes the coded information embedded in the TV signal and provides an indication to an operator of the various modes available with this particular program. ...The modes which may be made available include view only, view and tape for fee, and view and tape for free. Depending upon the mode selected, the TV program will then be routed along conductor 34 corresponding to view and tape for free; or through the copy protect circuit 36 where it would be formatted for to view and tape for a fee; or through antitape circuitry 38 where it would be formatted for view only....

Applicant submits that Horton at the given cite, arguably, teaches the view only, view and tape for fee and view and tape for free modes. Each of these steps, however, involves viewing the descrambled television program. This is different from “a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content.” For example, the language of claim 1 allows the storage device to “store the received broadcast content prior to viewing and without reproducing the received broadcast content.” Therefore,

Gotwald, Horton and Russo, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

Independent claims 7, 19 and 22 have been amended to recite features similar to those recited in amended independent claim 1. Therefore, Applicant respectfully submits that claims 7, 19 and 22 are not obvious and are patentable over Gotwald, Horton and Russo, taken alone or in combination, for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claim 7, 19 and 22.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, claims 4-6 also are non-obvious and patentable over Gotwald, Horton and Russo, taken alone or in combination, at least on the basis of their dependency from claim 1. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 12-18, 20-21 and 23-25 that depend from claims 7, 19 and 22 respectively, and therefore contain additional features that further distinguish these claims from Gotwald, Horton and Russo.

For at least the reasons given above, claims 1, 4-7 and 12-25 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1, 4-7 and 12-25 is respectfully requested. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish

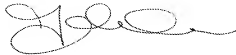
the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1, 4-7 and 12-25 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present patent application.

Respectfully submitted,

KACVINSKY LLC

A handwritten signature in black ink, appearing to read 'John F. Kacvinsky', with a long horizontal flourish extending to the right.

John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

Dated: November 19, 2007

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